

REMARKS

Claims 1-15 are now pending in this application for which applicants seek reconsideration.

Amendment

New claims 14 and 15 have been added to further protect the invention. New claim 14 is directed to a method and contains all of the elements of claim 1. New claim 15 depends from claim 14 and includes the method steps set forth in claim 13. No new matter has been introduced.

Rejoinder of Non-Elected Claims

Method claim 13 has been withdrawn as directed to a non-elected invention. New claims 14 and 15 are also believed to be directed to the non-elected invention since they claim a method. See the Restriction dated 03 November 2004. Nonetheless, as new claim 14 contains all of the elements of claim 1, if claim 1 is allowed, claim 14 MUST be rejoined and allowed together. In other words, per the decision in *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), if a method claim contains all of the elements of an allowed apparatus claim, then the method claim is allowable. See also MPEP § 821.04. Moreover, if claim 14 is allowed, then claim 15, which depends therefrom, is also allowable.

Art Rejection

Claims 1-12 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Sakai (JP 2002-312925) in view of Kawada (USPA 2004/0110034). The examiner relied upon Kawada for the proposition that using a NiFeNbB or NiFeSi orientation control layer over a Ta seed layer would have been obvious. Applicants submit that Kawada is not a viable prior art reference since the present application claims priority to JP 2002-342589, filed on 26 November 2002, which predates Kawada's § 102(e) date of 22 August 2003. In this respect, applicants enclose a certified English translation of the priority application to perfect priority.

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examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicants urge the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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Date

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